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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,635	07/17/2006	Pascal Arnaud	05725.1553	7496
22852	7590	08/26/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PURDY, KYLE A	
			ART UNIT	PAPER NUMBER
			1611	
			MAIL DATE	DELIVERY MODE
			08/26/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,635

Applicant(s)

ARNAUD, PASCAL

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-85 is/are pending in the application.
- 4a) Of the above claim(s) 61, 64, 65, 67, 68, 83 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-60, 62, 63, 66, 69-82 and 84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2 sheets (10/05/2006, 05/20/2008).

DETAILED ACTION

Election Acknowledged

1. Applicant's election with traverse of the invention of Group I encompassing claims 47-84 in the reply filed on 06/10/2009 is acknowledged. The traversal is on the ground(s) that Groups I and II should be rejoined because the invention of Group II requires Group I, and thus, unity exists. This is not found persuasive because a composition comprising a carboxylic acid esterified with a polyol has already been taught by the prior art. As such, the instant set of claims lack unity as the special technical feature had already been suggested by the prior art.

2. The requirement is still deemed proper and is therefore made FINAL.

Status of Application

3. Claims 47-85 are pending, claims 61, 64, 65, 67, 68, 83 and 85 are withdrawn as being directed to nonelected invention/species and claims 47-60, 62, 63, 66, 69-82 and 84 are presented for examination on the merits. The following rejections are made.

4. Note: claim 61 has been withdrawn as being directed to nonelected polyol. Claim 84 has been withdrawn as being directed to emulsion, rather than an anhydrous formulation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 47-60, 62, 63, 66, 69-82 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud (US 2002/0058054; published 05/16/2002) in view of Benítez et al. (US 4332738; published 06/01/1982).

8. Arnaud is directed to transfer-resistant cosmetic compositions comprising a variety of phases including a non-volatile silicone phase, a non-volatile hydrocarbon oil and an inert particular phase. It's taught that non-volatile hydrocarbon oil may be an ester in the form of a monoester, diester, and in general, polyesters (see [0078]). The esters are preferably branched and saturated and are preferably esters of C₂₋₁₈ acids and C₂₋₈ polyols (see [0079]). Exemplified and preferred esters include those derived from neopentanoic acid. Briefly, taught polyols include propylene glycol and neopentyl glycol (see [0079]). The ester is to be present in an amount of from 5-99% of the composition (see [0081]). In addition to the ester compound, the composition is to comprise a fatty constituent such as a mineral, animal or plant based oil (see [0083]). The composition is to also comprise a coloring agent in amount of between 0.01-70% (see [0098]). The composition is to also comprise a filler in an amount of between 0.1-30% (see

[0096]). The composition is to also comprise a wax in an amount of between 0.01-50% (see [0105]). Moreover, the composition may be anhydrous (see [0035]).

9. Arnaud fails to explicitly teach neopentyl glycol dineopentanoate.

10. Benitez is directed to esterification of neoacids by the use of cation exchange resins. Benitez is useful because it teaches how to synthesize such neoesters such that the product is high purity and the process is high yield. Exemplified neoacids include neopentanoic and neodecanoic acids (see claim 5). These acids are taught to be esterified with either monohydric or polyhydric alcohols (see column 3). The generic polyhydric species is as follows:



. $X_{3,4,5}$ may be, among others, hydrogen or C_{1-5} hydroxyalkyl. A particularly preferred polyol is that of pentaerythritol.

11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Arnaud and Benitez with a reasonable expectation for success in arriving at a composition comprising a fatty phase with a neopentanoic acid ester such as neopentyl glycol dineopentanoate. One would have been motivated to use the generic class of neopentanoic acids esters in the composition of Arnaud for several reasons. First, Arnaud while not specially teaching such a compound discloses both of the individual agents required to create the instant ester. Any person of ordinary skill in the art would have been capable of utilizing the preferred neopentanoic acid and esterifying it with the exemplified polyol, neopentyl glycol. Such a basic undertaking would result in a composition with the instantly claimed compound. Second, the instantly claimed species is encompassed by the teaching of Benitez which is directed to the manufacture of neoacid esters. It is acknowledged that Benitez

does not explicitly disclose the instantly claimed species. However, it would have been well within the purview of an ordinary person, especially in view of Arnaud, to arrive at the instant compound. It's noted that Benetiz is largely directed to the synthesis of neoacid esters, without any real purpose. However, Benitez incorporates various references (see column 1, for example) which are directed to the use of neoacids for use in cosmetic compositions to improve the properties thereof. Thus, while on its face Benitez is only drawn to synthesis of neoacids, Benitez as a whole would readily suggest to any ordinary person to use the disclosed neoacids in cosmetic compositions in order to improve the properties thereof. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
August 25, 2009*

*/David J Blanchard/
Primary Examiner, Art Unit 1643*